UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,904	01/10/2001	Ronald D. Ryan	13229RR (NORTH 2057000)	8289

			EXAMINER
21909	7590	03/03/2006	SHINGLES, KRISTIE D

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ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/757,904	RYAN ET AL.
	Examiner	Art Unit	
	Kristie Shingles	2141	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-15,23 and 25-28* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-15,23 and 25-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Per Applicant's Request for Continued Examination:

Claims 1, 3, 12, 23 and 28 have been amended.
Claims 2, 16-22, 24, 29 and 30 have been cancelled.
Claims 1, 3-15, 23 and 25-28 are pending.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection.   Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 12/19/2005 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1, 12, 23 and 28 have been considered but

are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1, 3-5, 11-15, 23, 25 and 28** are rejected under 35 U.S.C. 103(a) as being

unpatentable over *Patel* (US 6,131,032) in view of *Prieur* (US 6,470,075).

a. **Regarding claim 1,** *Patel* teaches a method of capturing communication

associated information (CAI) of a communication between a subject and an associate, the

method comprising the steps of:

- intercepting the communication, the communication comprising at least one packet and each packet comprising CAI (col.2 line 52-col.3 line 40, col.3 line 65-col.4 line 63; provision for communication-interception);

- providing an application identifier (AID) in the at least one packet of the communication, the AID identifying the format of the CAI (col.4 lines 52-62, col.8 lines 58-60, col.9 lines 1-12; the type of call is identified in the message which determines the format of the communication associated information);

- extracting in accordance with the AID the CAI from the at least one packet for reporting (col.4 line 58-col.5 line 4, col.6 lines 35-44, col.8 lines 5-12, col.9 lines 1-12);

- determining whether the extracted CAI is a new instance of the CAI (col.8 lines 13-18; determination for whether the communication associated information and subscriber are new); and

- reporting a first message to a Law Enforcement Agency (LEA) in response to a determination that the extracted CAI is the new instance of the CAI (pa: col.8 lines 13-50).

Yet, *Patel* fails to explicitly teach determining whether a predetermined amount

of time has elapsed between packets of the at least one packet of the communication, the packets

being identified by the CAI; and reporting a second message to an LEA in response to a

determination that the given amount of time has elapsed, wherein the second message represents

a timeout indication. However, *Prieur* teaches a timer and selected time period wherein upon

expiration of the time period the marking means for the LEA is informed by the counting means

to un-mark the particular user and to cease monitoring and interception for the user (col.2 lines

15-33, col.7 lines 27-45, col.8 lines 13-25).

Therefore it would have been obvious to one of ordinary skill in the art at the time

the invention was made to combine the data-interception system of *Patel* with *Prieur* in order to

implement a timer that tracks the amount of time a user's communication is intercepted and to

subsequently providing a means for indicating to the LEA when that amount of time has expired,

for efficient tracking of the intercepted communication that adhere to the imposed legal

procedures.

b.   **Claims 12, 23 and 28** contain limitations that are substantially equivalent to

claim 1 and are therefore rejected under the same basis.

c.   **Regarding claim 3,** *Patel* and *Prieur* teach the method of claim 1, *Prieur* further

teaches wherein the second message comprises at least one of a subject identifier, a time stamp

indicating when the message was sent, the IP address of the subject, a packet direction indicator

identifying whether the message was sent or received by the subject, the IP address of the

associate, a first instance indicator identifying the new instance of the CAI, and a counter

indicating the number of packets identified by the CAI seen since a last message (col.4 lines 8-

38, col.5 line 8-col.6 line 2, col.7 line 11-col.8 line 29; *Patel*: col.9 lines 1-12).

d.   **Regarding claim 4,** *Patel* and *Prieur* teach the method of claim 1, *Prieur* further

teaches determining whether a given number of packets of the at least one packet of the

communication has been intercepted, the packets being identified by the CAI; and reporting a

third message in response to a determination that the given number of packets identified by the

CAI has been intercepted (col.8 lines 1-29).

e.   **Claims 5 and 11** are substantially equivalent to claim 3 and are therefore rejected under the same basis.

f.   **Claim 25** is substantially equivalent to claim 4 and is therefore rejected under the same basis.

g.   **Regarding claim 13,** *Patel* and *Prieur* teach the method of claim 12, *Patel* further teaches wherein the step of determining whether a packet is a new instance of the CAI is performed by comparing the CAI with a previous CAI (col.7 line 65-col.8 line 38).

h.   **Regarding claim 14,** *Patel* and *Prieur* teach the method of claim 12, *Patel* further teaches wherein the step of determining whether a packet is a new instance CAI is performed by allowing a given amount of time to elapse since the receipt of the at least one packet (col.7 line 65-col.8 line 29).

i.   **Regarding claim 15,** *Patel* and *Prieur* teach the method of claim 12, *Patel* further teaches wherein the CAI report comprises at least one of a subject identifier, a time stamp indicating when the message was sent, the IP address of the subject, a packet direction indicator identifying whether the message was sent or received by the subject, an associate identifier, a first instance indicator identifying the new instance of the CAI, and a counter indicating the number of packets identified by the CAI seen since a last report (col.8 lines 5-38 and 52-60, col.9 lines 1-12).

5.   <u>Claims 6-8</u> are rejected under 35 U.S.C. 103(a) as being unpatentable over *Patel* (US 6,131,032) and *Prieur* (US 6,470,075) in view of *Applicant Admitted Prior Art* (hereafter referred to as *AAPA*).

a.   **Regarding claim 6,** *Patel* and *Prieur* teach the method of claim 1 as applied above, *Patel* specifically teaches that the type of call is identified in the message (col.4 lines 52-62, col.8 lines 58-60, col.9 lines 1-12), yet *Patel* and *Prieur* fail to explicitly teach the method wherein the AID is located in the Network Layer 3. However, *AAPA* teaches wherein the AID is located in the Network Layer 3 (page 2, line 26 – page 3, line 5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data-interception system of *Patel* and *Prieur* with *AAPA* wherein the AID is located in the Network Layer 3 because it is well known in the art that different applications store AID in various Network Layers and email service providers utilize Layer 3 to store AID (email being a form of network communication).

b.   **Regarding claim 7,** *Patel* and *Prieur* teach the method of claim 1 as applied above, *Patel* specifically teaches that the type of call is identified in the message (col.4 lines 52-62, col.8 lines 58-60, col.9 lines 1-12), yet *Patel* and *Prieur* fail to explicitly teach the method wherein the AID is located in the protocol field of the Network Layer 3. However, *AAPA* teaches wherein the AID is located in the protocol field of the Network Layer 3 (page 2, line 26 – page 3, line 5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data-interception system of *Patel* and *Prieur* with *AAPA* wherein the AID is located in the Network Layer 3 because it is well known in the art that different applications store AID in various Network Layers and email service providers utilize Layer 3 to store AID (email being a form of network communication).

c.   **Regarding claim 8,** *Patel* and *Prieur* teach the method of claim 1 as applied above, *Patel* specifically teaches that the type of call is identified in the message (col.4 lines 52-62, col.8 lines 58-60, col.9 lines 1-12), yet *Patel* and *Prieur* fail to explicitly teach the method wherein the AID is located in the optional field of the Network Layer 3. However, *AAPA* teaches wherein the AID is located in the optional field of the Network Layer 3 (page 2, line 26 – page 3, line 5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data-interception system of *Patel* and *Prieur* with *AAPA* wherein the AID is located in the Network Layer 3 because it is well known in the art that different applications store AID in various Network Layers and email service providers utilize Layer 3 to store AID (email being a form of network communication).

6.   **Claims 9, 10, 26 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Patel* (US 6,131,032) and *Prieur* (US 6,470,075) in view of *Dougherty et al* (US 6,363,525).

a.   **Regarding claim 9,** *Patel* and *Prieur* teach the method of claim 1 as applied above, *Patel* specifically teaches that the type of call is identified in the message (col.4 lines 52-62, col.8 lines 58-60, col.9 lines 1-12), yet *Patel* and *Prieur* fail to explicitly teach the method further comprising the step of: providing an AID-tag in the at least one packet of the communication, the AID-tag indicating the presence of the AID. However, *Dougherty et al* teach wherein the method further comprises the step of: providing an AID-tag in the at least one packet of the communication, the AID-tag indicating the presence of the AID (col.2 lines 26-35, col.8 lines 14-40, col.11 line 50-col.12 line 15, col.23 lines 4-12, col.25 lines 31-47).

Therefore it would have been obvious to one of ordinary skill in the art at the time

the invention was made to combine the data-interception system of *Patel* and *Prieur* with

Dougherty et al wherein the method further comprises the step of: providing an AID-tag in the at

least one packet of the communication, the AID-tag indicating the presence of the AID because

depending on the application the CAI is provided in either Layer 3 or 7 of the packet and thus by

identifying the type of application the system knows where to extract the CAI from without

having to illegally search the whole packet, including the communication content, thus making

the system legal and efficient.

b.   **Claim 26** is substantially equivalent to claim 9 and is therefore rejected under the

same basis.

c.   **Regarding claim 10,** *Patel* and *Prieur* teach the method of claim 1 as applied

above, *Patel* specifically teaches that the type of call is identified in the message (col.4 lines 52-

62, col.8 lines 58-60, col.9 lines 1-12), yet *Patel* and *Prieur* fail to explicitly teach the method

further comprising the steps of: providing an AID-tag in the at least one packet of the

communication, wherein the AID-tag indicates the presence of the AID, and wherein the AID-

tag is located in the protocol field of the Network Layer 3. However, *Dougherty et al* teach

wherein the method further comprises the steps of: providing an AID-tag in the at least one

packet of the communication, wherein the AID-tag indicates the presence of the AID, and

wherein the AID-tag is located in the protocol field of the Network Layer 3 (col.2 lines 26-35,

col.8 lines 14-40, col.11 line 50-col.12 line 15, col.23 lines 4-12, col. 25 lines 31-47).

Therefore it would have been obvious to one of ordinary skill in the art at the time

the invention was made to combine the data-interception system of *Patel* and *Prieur* with

Dougherty et al wherein the method further comprising the steps of: providing an AID-tag in the at least one packet of the communication, wherein the AID-tag indicates the presence of the AID, and wherein the AID-tag is located in the protocol field of the Network Layer 3 because depending on the application the CAI is provided in either Layer 3 or 7 of the packet and thus by identifying the type of application the system knows where to extract the CAI from without having to illegally search the whole packet including the communication content thus making the system legal and efficient.

     d.   **Claim 27** is substantially equivalent to claim 10 and is therefore rejected under the same basis

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Dikmen et al* (US 6,577,865), *Haumont* (US 6,654,589), *Blanchard et al* (US 6,141,548), *Comer et al* (US 6,823,185), *Gressel et al* (US 5,852,665), *Agre et al* (US 6,073,013), *Ruppert et al* (US 6,738,902), *Magnusson* (US 6,122,499), *Hippelainen* (US 2002/0078384).

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds